

### **REMARKS**

Claims 1-16 are pending. No new matter has been added by way of the present amendment. For instance, a period has been added to claim 14. Also, newly added claim 16 is supported by the textual subject matter of originally filed claim 2. Accordingly, no new matter has been added.

In view of the following remarks, Applicants respectfully withdraw all rejections and allow the currently pending claims.

### **Issues under 35 U.S.C. §112, second paragraph**

The Examiner has rejected claim 2 under 35 U.S.C. §112, second paragraph for the reasons recited at page 5 of the outstanding Office Action. Applicants respectfully traverse. In particular, the Examiner has asserted that the definition for "R<sup>14</sup>" in formula (7) of claim 2 is absent. Applicants respectfully disagree. The definition of R<sup>14</sup> is provided at line 9 of claim 2 (counting the formulas as two lines). Accordingly, this rejection is improper and should be withdrawn.

### **Obviousness-Type Double Patenting**

The Examiner has provisionally rejected claims 1-5 under the judicially created doctrine of obviousness-type double patenting as being obvious over claims 1-9 of co-pending Application No. 10/679,367. Application No. 10/679,367 is also published as U.S. Publication 2005/0095527A1. Applicants traverse.

The provisional obviousness-type double patenting rejection is improper. Applicants point out that co-pending Application No. 10/679,367 does not share the same assignee as the present application. In particular, the assignee of the co-pending application is JSR. In contrast, the present application is assigned to Shin-Etsu Chemical Co., Ltd. Accordingly, pursuant to MPEP §804(B)(1) the obviousness-type double patenting rejection is improper. The Examiner is therefore respectfully requested to withdraw this rejection.

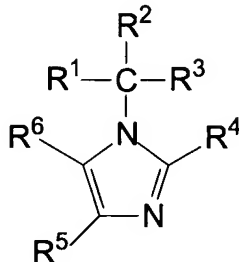
**Issues under 35 U.S.C. §103(a)**

The Examiner has rejected claims 1-5 under 35 U.S.C. §103(a) as being obvious over U.S. Publication 2005/0095527A1 (hereinafter referred to as U.S. '527). Applicants traverse.

**The Present Invention and Its Advantages**

An object of the present invention to provide a resist composition which has a high resist film thickness loss preventing effect, and also has a high resolution and a good focus margin widening effect. According to the present invention, basic compounds of general formula (1) having the benzimidazole skeleton, especially general formulae (2) to (7), which have polar functional groups such as ester, cyano or acetal and have a benzimidazole skeleton, are added in an appropriate amount to a resist. These compounds are highly effective for preventing a loss of resist film thickness and endow the resist composition with a high resolution and a focus margin widening effect.

In contrast, U.S. '527 discloses the use of the following imidazole compound:



wherein R<sup>1</sup>, R<sup>2</sup>, R<sup>3</sup>, R<sup>4</sup>, R<sup>5</sup>, and R<sup>6</sup> individually represent a hydrogen atom, cyano group, substituted or unsubstituted alkyl group having 1-20 carbon atoms, substituted or unsubstituted alicyclic group having 3-20 carbon atoms, substituted or unsubstituted alkenyl group having 2-20 carbon atoms, substituted or unsubstituted aryl group, or substituted or unsubstituted heteroaryl group, provided that any two groups selected from R<sup>1</sup>, R<sup>2</sup>, R<sup>3</sup>, R<sup>4</sup>, R<sup>5</sup>, and R<sup>6</sup> may be bonded together to form a ring which may comprise a hetero atom or may bond together to form a dimer.

Although U.S. '527 discloses R<sup>5</sup> and R<sup>6</sup> may be bonded together to form a ring, it fails to disclose and teach a benzimidazole skeleton. Since a benzimidazole skeleton cannot be motivated from the disclosure of U.S. '527 even for one of ordinary skill, the presently claimed invention is non-obvious. Rather, Applicants submit that the Examiner's assertion is a hindsight.

Moreover, the object of U.S. '527 is to provide a composition useful as a chemically amplified resist exhibiting high storage stability. On the other hand, an object of the present invention is to provide a resist composition having a high resist film thickness less preventing effect and a good focus margin widening effect.

Accordingly, the effect of the present invention in which a benzimidazole compound is used is not expected from U.S. '527. Thus, any hypothetical *prima facie* case of obviousness is

moot in view of the unexpectedly superior effect of the present invention. Reconsideration and withdrawal of this rejection are therefore requested.

In view of the above, Applicants respectfully submit that the present claims define subject matter which is patentable over the cited art. Accordingly, the Examiner is respectfully requested to withdraw all rejections and allow the currently pending claims.

If the Examiner has any questions or comments, please contact Craig A. McRobbie, Registration No 42,874 at the offices of Birch, Stewart, Kolasch & Birch, LLP.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to our Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under § 1.17; particularly, extension of time fees.

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Respectfully submitted,

By  42-874

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